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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
MARKS, CHRISTINA M

ART UNIT	PAPER NUMBER
3713	4

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/966,851	MUIR, DAVID HUGH	
	Examiner	Art Unit	
	C. Marks	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 September 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) *28* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *19-22,24-27 and 29* is/are rejected.

7)☒ Claim(s) *1-18 and 23* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 and those dependent therefrom, are rejected as it is not readily understood by one of ordinary skills in the art as to what is defined by the limitation of the claim in regard the type of evaluation method and how the evaluation methods differ.

For examination purposes, and as a suggested correction, the Examiner will examine the claim, as best understood, to read as follows (starting at line 8 and ending at line 13):

"said controller being programmed to receive a player selected game option from said user input device, the player selected game option being indicative of only one of a first win evaluation method or a second win evaluation method, wherein the first win evaluation method is different than the second win evaluation method, and wherein the first win evaluation method is a three-dimensional win evaluation method,"

Claim Objections

Claim 28 objected to for depending on claim 32, which is not present in the case. Further, the intended dependency cannot be readily and clearly be determined so the claim has been withdrawn from consideration.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 19-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada (US Patent No. 5,152,529).

Okada discloses a gaming apparatus that includes a user input device (FIG 1, reference 12), a value input device (FIG 1, reference 10), a controller (FIG 4, reference 45) that is coupled to the user input device (FIG 4, reference 61) and the value input device (FIG 4, reference 63). The controller comprises memory (FIG 4, reference 67) and inherently has a processor. The controller is programmed to allow a person to make a wager (Column 2, lines 65-67). The controller then causes the reels to begin to rotate (Column 2, lines 65-68).

The reels have a plurality of symbols (FIG 2) and the symbols are depicted in a first and second geometric plane wherein the geometric planes are different from each other (FIG 1 and

FIG 2). The controller is also programmed to determine a value payout associated with an outcome of the slots based upon the configuration of the symbols (Column 3, lines 1-8).

The device is further programmed to allow the user to make a payline selection (Column 2, lines 53-62). This payline inherently includes a three-dimensional payline selection as the payline runs through the first reel (FIG 1 and FIG 2) which has three-dimensional characteristics.

Okada does not explicitly disclose a display unit that causes a video image to be displayed instead of the reels; however, Okada discloses the present invention is also applicable to a video type slot machine wherein the symbols are displayed on a CRT screen of a graphic display unit (Column 2, lines 1-3. Thus a video image depicting the reels would be obvious. Further, it would have been obvious that to implement the disclosed system of Okada on a video CRT, a transparent overlay would be used to simulate the three-dimensional effect disclosed.

It is well known in the art that the instructions used to control the processor are stored as a computer program in memory to allow for execution. Okada discloses such a computer program storage area that is coupled to the controller (FIG 4, reference 66).

This program stored in memory would inherently be in charge of controlling the function of the gaming machine, as is well known in the art. The memory, which would have been obvious to one of ordinary skill in the art to partition, would execute a program to accept wagers, control the reels, and determine the associated payout based upon an evaluation method as chosen by the player.

Further based on the paylines selected, including three-dimensional paylines, the memory would select an associated paytable (Column 2, lines 55-64), as it is notoriously well known in the art that when multiple paylines are wagered upon, it is obvious to alter the paytable to

accommodate the multiple paylines. Based upon the completion of the player making their payline selections, the program will cause the apparatus to spin and select a reel strip layout from a plurality of reel strip layouts (Column 6, lines 7-30).

As disclosed above, it would be obvious to the device of Okada to display the reels in video format and use a transparent overlay to simulate the three-dimensional effect. This overlay would be inherently generated under the control of the program stored in memory.

The three-dimensional evaluation method that is disclosed by the system of Okada relates to Z-layer interaction (FIG 1 and FIG 2) and as stated above will be evaluated by the program instructions stored in memory.

Allowable Subject Matter

Claims 1-18 would be allowable based upon the interpretation of the clause in claim 1 as disclosed above. The claims would be allowable over the prior art of record, if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, and as interpreted by the Examiner as set forth in this Office action.

Claim 1 defines over the prior art of Inoue (US Patent No. 5,752,881), Okada (US Patent No. 5,152,529), Inoue (US Patent No. 5,395,111) and Loose et al. (US Patent No. 6,517,433).

The prior art of record allows the player to select a type of game wagering option from the input device. However, the selection is based on the location of the payline and can be of more than one type based upon the setup of the machine. The payline can represent both a normal two-dimensional payline as well as a three-dimensional payline and is not solely indicative of only one. The paylines can indeed represent two different evaluation methods and the evaluation method that will actually be used is based not upon the option selected by the

player, as the player can only select the action line – not whether the evaluation result will be in two or three dimensions. The evaluation method actually used will be based upon the stop position of the reels and not the paylines that have been chosen by the player.

Claim 23 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Though Okada discloses a video embodiment, Okada does not allow the player to position the transparent overlay, indicative of a three-dimensional wager, by dragging it and placing it over any of the slot machine symbols to create a three-dimensional wager. The transparent overlay of Okada is set in place and selected by the processor and player input for choosing its location is not disclosed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6,086,066: Reel apparatus that includes a three-dimensional aspect that is enacted upon the player winning a certain jackpot.

US Patent No. 6,322,445: Gaming apparatus that discloses a number of paylines that are available to a gaming machine. Discloses a number of variations for types of paylines.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael O'Neill, Acting SPE, can be reached on (703)-308-3484. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9302 for regular communications and (703)-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

cmm
cmm
June 9, 2003

MICHAEL O'NEILL
PRIMARY EXAMINER